

THIS DISPOSITION IS NOT
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OF THE TTAB MAY 9, 00

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

FSW

Opposition Nos. 86,313 and
87,206¹

GSG Enterprises Inc. d/b/a
Learning Tree University

v.

Learning Tree International,
Inc., a/k/a Learning Group
International, Inc., a/k/a
Integrated Computer Systems
Publishing Company, Inc.

Before Quinn, Holtzman and Rogers,
Administrative Trademark Judges.

By the Board:

This consolidated proceeding involves applicant's right
to register the mark LEARNING TREE INTERNATIONAL (alone or
with a Tree Design), as set forth below:

¹ The cases involve common questions of law or fact; therefore
consolidation is appropriate. See Fed. R. Civ. P. 42(a); and TBMP
Section 511.

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Ser. No.	Mark	Goods/Services
74/115,628	LEARNING TREE INTERNATIONAL	Educational services; namely, conducting courses in engineering, science, business, management, communications, computers, electronics, and manufacturing.
74/115,629	LEARNING TREE INTERNATIONAL	Books relating to engineering, science, business, management, communications, computers, electronics, and manufacturing.
74/115,633	LEARNING TREE INTERNATIONAL	Computer hardware; namely, microcomputers, keyboards, video displays, and power supply units; computer programs, and pre-recorded audio and video tapes, cassettes, and disks for educational purposes.
74/115,634	 Learning Tree International	Books relating to engineering, science, business, management, communications computers, electronics, and manufacturing.
74/115,700	 Learning Tree International	Educational services; namely, conducting courses in engineering, science, business, management, communications, computers, electronics, and manufacturing.
74/115,627	 Learning Tree International	Computer hardware; namely, microcomputers, keyboards, video displays, and power supply units; computer programs, and pre-recorded audio and video tapes, cassettes, and disks for educational purposes.

The drawings in the above design marks are lined for the colors red and blue.

A civil action that occasioned the lengthy suspension of these cases having been finally determined, proceedings

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are resumed and these cases now come up on applicant's motion for **summary judgment**, filed April 27, 1992, and on opposer's cross-motion for **summary judgment**, filed May 19, 1992. Applicant renewed its motion on January 3, 1994, and on April 13, 1999; opposer renewed its motion on May 3, 1999. The motions have been fully briefed.

Applicant, in its motion, contends that opposer cannot be damaged by registration of the LEARNING TREE INTERNATIONAL mark because the terms of the 1987 consent judgment between the parties, and the 1997 affirmance by the Court of Appeals for the Ninth Circuit of a district court order clarifying the consent judgment,² allow applicant to use the mark; and because applicant owns other registrations for legally equivalent marks. Applicant further contends that because opposer's rights are "expressly restricted" to a limited geographic area, opposer has no standing to bring this opposition.

Opposer, in its cross-motion for **summary judgment**, argues that it has standing to bring this opposition as the senior user of the mark LEARNING TREE UNIVERSITY; that applicant's Morehouse defense does not apply; and that while the consent judgment gave both parties the right to use marks containing the words LEARNING TREE, it did not give

² See discussion of prior case history, *infra*.

applicant the right to use the different mark LEARNING TREE INTERNATIONAL.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. See Fed. R. Civ. P. 56(c); Celotex Corp. v. Catrett, 477 U.S. 317 (1986); Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

In considering whether to grant or deny a motion for **summary judgment**, the Board may not resolve issues of material fact, but can only ascertain whether genuine disputes exist regarding such issues. Opryland USA, *supra*, and Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

Opposer's Standing

A party may establish its standing to oppose by showing that it has a "real interest" in the case, that is, a **direct and personal stake in the outcome of the opposition**. See

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Ritchie v. Simpson, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999);
Lipton Industries, Inc. v. Ralston Purina Co., 213 USPQ 185,
189 (CCPA 1982); TBMP §303.03 and authorities cited in that
section.

Opposer has shown that it has a legitimate personal
interest in the opposition and has pleaded facts which, if
proven at trial, would establish its standing. Opposer
submitted the affidavit of B. Michael Gould, alleging
opposer's priority of use of marks it contends are
confusingly similar to applicant's marks. Opposer asserts
that it will be damaged by registration of applicant's
marks. There is no genuine issue as to opposer's standing.
To the extent that applicant seeks summary judgment on
opposer's lack of standing, applicant's motion is denied.

The Morehouse Defense

Applicant asserts that opposer cannot be damaged by the
registration of its pending applications because applicant
already owns four registrations for substantially the same
marks and goods. See Morehouse Mfg. Corp. v. J. Strickland
Co., 407 F.2d 881, 160 USPQ 715, 717 (CCPA). These
registrations (see below) were not involved in the prior
civil action.

Reg. No.	Mark	Goods
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- | | | |
|-----------|---|--|
| 1,506,873 | FROM THE
LEARNING
TREE | Computer hardware, namely, microcomputers, keyboards, video displays, and power supply units; computer programs; and prerecorded audio and video tapes and cassettes. |
| 1,506,875 | LEARNING
TREE | Computer hardware, namely, microcomputers, keyboards, video displays, and power supplies, computer programs; and prerecorded audio and video tapes and cassettes. |
| 1,481,464 |  | Computers, computer peripherals, and audio and video tapes, Cassettes, discs and computer programs. |
| 1,305,728 |  | Prerecorded video tapes and video tape cassettes containing instruction in electronics and computers; printed instructional material in the field of electronics and computers-namely, tutorial workbooks. |

For ownership of one or more existing registrations to be an affirmative defense to an opposition, the pre-existing registration or registrations must be for the same or substantially identical mark. See, DC Comics Inc. v. Scholastic Magazines, Inc., 210 USPQ 299, 301 (TTAB 1980)(DOUBLE ACTION not the same or substantially identical to ACTION and SCHOLASTIC ACTION; summary judgment denied); Compania Insular Tabacalera, S. A. v. Camacho Cigars, Inc., 167 USPQ 299, 303-304 (TTAB 1970)(DON MARCOS is not a "natural extension" of applicant's previously used and registered trademark SAN MARCO, both for cigars; "[T]he test is not whether or not "DON MARCOS" is confusingly similar to "SAN MARCO" ... [but] is much narrower and is, in effect, a determination as to whether or not the marks are and would be recognized as one and the same mark.").

In this case, none of the registered marks is the same as or substantially identical to any of the applied-for marks. The registered design marks are not lined for color, as are the applied-for marks. The registered marks do not include the word INTERNATIONAL, as do the applied-for marks. Opposer argues that the word INTERNATIONAL has little or no trademark significance and therefore is typically disclaimed. However, when comparing marks, even if a word may be said to have less significance than other features, the Board looks to the overall commercial impression made by the mark, including weak or disclaimed elements. Moreover, in some of its own applications, applicant has disclaimed the word "LEARNING," but not the word "INTERNATIONAL."³

Accordingly, applicant's ownership of the prior registrations is not a sufficient defense to opposer's challenge to applicant's right to register the mark LEARNING TREE INTERNATIONAL (alone or with the Tree Design).

Claim Preclusion⁴

³ Applicant has disclaimed the word "INTERNATIONAL" in two of the six involved applications. In the other four, the word "LEARNING" was disclaimed; "INTERNATIONAL" was not disclaimed.

⁴ Here, the species of res judicata involved is claim preclusion, rather than issue preclusion, inasmuch as no issues were actually litigated in the civil action, but rather, claims were resolved by consent judgment. See Mother's Restaurant Incorporated v. Mama's Pizza Inc., 723 F.2d 1566, 221 USPQ 294 (Fed. Cir. 1983); and Institut National Des Appellations d'Origine v. Brown-Forman Corp., 47 USPQ2d 1875 (TTAB 1998).

These cases were suspended in 1992, pending resolution of a civil action⁵ in which the interpretation of a clause in the parties' 1987 consent judgment was adjudicated. That clause, contained in paragraph 2 of the consent judgment, provides, in relevant part, as follows:

ICSP [applicant herein] shall not use the words 'Learning Tree' or forms thereof in Ventura, Los Angeles, and Orange Counties in its tradename or in its service marks or trademarks other than on or in association with the goods and services in the registrations cited above, or in association with professional development courses and on goods related thereto.

Subject to the provisions of paragraph 2, the parties further agreed in the consent judgment that applicant "has the exclusive rights to use the registered marks throughout the United States on the goods and in association with the services as set forth in those registrations and for professional development courses and goods."

Applicant's prior registrations, referred to in the consent judgment, are:

Reg. No.	Mark	Goods
1,124,714	LEARNING TREE	Educational publications-namely, course notes, and reprints of technical articles and manufacturers' literature; educational services-namely, conducting courses in computer technology with emphasis toward minicomputers and microcomputers.

⁵ Integrated Computer Systems Publishing Co., Inc. v. The Learning Tree Open University, G.S.G. Enterprises, Case No. CV 84-8461-R and Case No. CV 84-8461-FW, in the United States District Court for the Central District of California.

1,178,577 FROM THE
LEARNING TREE

Educational publications-namely, course notes, and reprints of technical articles and manufacturer's literature; educational services-namely, conducting courses in computer technology with emphasis toward minicomputers and microcomputers.

1,127,873



Educational publications-namely, course notes, and reprints of technical articles and manufacturer's literature; educational services-namely, conducting courses in computer technology with emphasis toward minicomputers and microcomputers.

The 1987 consent judgment permits applicant to use the words LEARNING TREE or "forms thereof," as a trademark or service mark. In 1990, following applicant's name change, opposer moved the court for an order finding applicant in contempt of the consent judgment.⁶ In 1995, the U.S. District Court for the Central District of California clarified "paragraph 2" of the consent judgment as permitting applicant to use LEARNING TREE INTERNATIONAL as a "corporate name" and as a "tradenname" throughout the country, even in the tri-county region in which opposer was held to have the right to use its LEARNING TREE UNIVERSITY mark. However, applicant's rights to use its marks,

⁶ The judgment itself does not articulate the criteria for determining whether a proposed mark would qualify as a "form" of LEARNING TREE, and applicant's subsequent name change to LEARNING TREE INTERNATIONAL appears to have been beyond the parties' contemplation at the time the consent judgment was entered. The district court's holding of contempt was vacated on appeal.

including LEARNING TREE INTERNATIONAL, within the tri-county area is limited by the consent judgment.⁷

In 1997, the Court of Appeals for the Ninth Circuit affirmed the lower court's 1995 order clarifying the consent judgment.⁸ Reasoning that it would be difficult to conclude that applicant's use of LEARNING TREE INTERNATIONAL as a trademark would not violate trademark law, but that its use of the words as a trade name would, the appellate court affirmed applicant's right to use LEARNING TREE INTERNATIONAL not only as a trade name, but also as a trademark or service mark "in the tri-county region under certain circumstances."

We readily confess that, after repeated readings of the district court's "Clarifying Order" and the Ninth Circuit's subsequent opinion, we are not sure that we understand fully the terms of the consent judgment or the "certain circumstances" under which applicant may use LEARNING TREE INTERNATIONAL as a trademark or service mark. However, as best we understand these documents, we believe those

⁷ The clarifying order, despite its ambiguities, does not restrict applicant's right to use LEARNING TREE INTERNATIONAL as a trade name. The district court's reference to "the goods and services in the registrations" is, by its terms, a restriction on applicant's right to use the words as a mark rather than as a trade name.

⁸ Integrated Computer Sys. Publ. Co. v. Learning Tree Univ., 121 F.3d 715, 1997 U.S. App. LEXIS 40703 (9th Cir. Cal. 1997); reported in full at Integrated Computer Sys. Publ. Co. v. Learning Tree Univ., 1997 U.S. App. LEXIS 19790 (9th Cir. Cal. July 29, 1997).

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circumstances are that, in the tri-county area, applicant may use LEARNING TREE INTERNATIONAL as a trade name, and as a mark on those goods and services that are either recited in the three registrations identified in the consent judgment, or in association with professional development courses, or on goods related to professional development courses. Outside the tri-county area, applicant's right to use LEARNING TREE INTERNATIONAL as a trade name or mark is not restricted to use on or in connection, or in association with, any specific goods or services.

Applying the terms of the consent judgment as we have interpreted them, the marks in applicant's six applications meet the criteria as "forms" of LEARNING TREE. The goods and services also meet the identification requirements. Two of the applications cover educational services in fields encompassed by the phrase "professional development courses." The other applications cover goods that are related to either the printed publications listed in the prior registrations, or are related to the permitted educational services, or to professional development courses.

In view thereof, applicant is entitled to geographically-unrestricted registrations of its various

LEARNING TREE INTERNATIONAL marks, as set forth in the six applications involved in these proceedings.⁹

The identifications of goods in application Ser. Nos. 74/115,633 and 74/115,627 include computer programs and pre-recorded audio and video tapes, cassettes and disks for educational purposes. Since 1991, when these marks were published, the requirements for identification of media upon which information is recorded, such as computer programs and tapes, cassettes and disks, has changed. Accordingly, following entry of judgment herein, these two applications will be remanded to the examining attorney for a determination of the sufficiency of the identification of goods. See, e.g., TMEP §804.03(b) - "Identifying Computer Programs with Specificity."

Summary

The parties to these proceedings have been engaged in protracted litigation both in federal court and before the Board. The notices of opposition were filed in 1991, nearly a decade ago. However, the Board is an administrative tribunal with jurisdiction over the question of

⁹ Whether opposer is also entitled to any registrations of any of its marks is not before us. To the extent the parties are seeking concurrent use registrations, they are advised that concurrent rights are considered and determined by the Board only in the context of a concurrent use proceeding. See Trademark Rule 2.133(c); TBMP §§1101.02 and 1102; and TMEP 207.04. A concurrent use proceeding will not be instituted unless there is a concurrent use application to be considered. Neither applicant nor opposer currently has such an application pending.

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registrability only. See Section 17 of the Trademark Act and TBMP §102.01.

Applicant's motion for summary judgment is granted, except to the extent applicant seeks summary judgment on the ground of opposer's lack of standing; and opposer's cross-motion for summary judgment is denied.

Judgment is entered against opposer and the oppositions are dismissed with prejudice.

T. J. Quinn

T. E. Holtzman

G. F. Rogers
Administrative Trademark Judges
Trademark Trial and Appeal Board